

## REMARKS/ARGUMENTS

This Response is being submitted in response to the Office Action dated September 21, 2003. Claims 11-15, 19-26, and 28-32 were pending in this application prior to this Response and claims 11-15, 19-26, and 28-32 stand rejected. Claims 1-10 and claims 16-18 and 27 were previously canceled. Reconsideration and reexamination are respectfully requested.

### **Premature Final**

Applicant respectfully submits that due to the new rejection under 35 USC § 112, particularly as to the "definiteness" of the term "extract" in the claims (see argument below). As this rejection was "a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement," it was premature under MPEP706.07(a), and thus must be withdrawn. Action to this end is respectfully requested.

### **Rejections Under 35 U.S.C. § 112, second paragraph**

Claims 11-15, 19-25, and 31 stand rejected under 35 USC §112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner has stated that claims 11-15, 19-25, and 31 stand rejected as indefinite because "the term "extract" renders the claim(s) 11-15, 19-25, and 31 are vague and indefinite in scope as to the structure(s) or compound(s) within the composition." Applicants respectfully traverse this rejection for at least the reasons discussed below.

Applicants have disclosed the extraction process in the description of the preferred embodiment section of the initial patent filing. Specifically, the description sets forth the steps of placing Kaempferia Galanga root "in an alcohol bath, heating in

the alcohol bath to extract the cinnamate from the root, separating the alcohol solution from the root residue, and thereafter heating the alcohol extract for a time sufficient to evaporate substantially all of the alcohol therefrom." (Applicants' Specification, paragraph 0004, 1<sup>st</sup> sentence.) The result is a sufficiently definite root extract for compliance with 35 USC 112.

The test for definiteness is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986), and see MPEP 2173.02 Clarity and Precision [R-3] - 2100 Patentability. All that need be understood by skilled artisans is that the claim covers root extracts of *Kaempferia Galanga*. This is a definite plant root, definitively extracted. A skilled artisan would understand that any extract from this root falls within the claims. Therefore, the term "extract" in the claims is not vague or indefinite.

Moreover, the use of the term "extract" is common in patent lexicography relating to derivatives of organic matter, as evidenced by the patents and prior art listed in the brief summary of the invention section of the initial patent filing. Use of the term "extract" does not render the claims of a patent indefinite or vague, as often the term "extract" is the most accurate and complete means of describing a constituent and essential ingredient of the claimed invention.

Furthermore claim 14 specifically states that the root extract of *Kaempferia Galanga* comprises ethyl p-methoxycinnamate. Applicants submit that the term "extract" and its further definition in the disclosure and in claim 14 is definite for at least the above reasons and further because it more specifically further limits to ethyl p-methoxycinnamate. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 11-15, 19-25, and 31, and respectfully request that the claims be allowed.

#### Rejections Under 35 U.S.C. § 102(b)

Claims 11-12, 14-23, 19-22, 24-26, 28, and 30-32 stand rejected under 35 § USC 102(b) as purportedly being anticipated by Voss et al. (U.S. Patent No. 5,972,315; hereinafter "Voss"). Specifically, the Examiner has rejected these claims, "...in view of

Example 1b, wherein the concentration of the ethyl p-methoxycinnamate is 2%." Applicants respectfully traverse this rejection for at least the reasons discussed below.

Applicants' claim 11 recites:

A composition for protecting mammalian skin from discoloration or harmful effects of tyrosinase or chemically induced irritation other than UV radiation consisting essentially of an effective amount of up to about 5% by weight of a root extract of Kaempferia Galanga.

Applicants' claim 21 recites:

A composition for protecting mammalian skin from discoloration or harmful effects of tyrosinase or chemically induced irritation other than UV radiation comprising a preparation containing, in weight percent, an effective amount up to about 5 percent of a root extract of Kaempferia Galanga dispersed in a carrier.

Applicants' claim 26 recites:

A composition for protecting mammalian skin from discoloration or the harmful effects of tyrosinase or chemically induced irritation other than UV radiation comprising a preparation containing, in weight percent, an effective amount up to about 5 percent of ethyl p-methoxycinnamate dispersed in a carrier; wherein the ethyl p-methoxycinnamate is extracted from Kaempferia Galanga root.

As a preliminary matter, Voss does not teach or suggest inclusion of "a root extract of Kaempferia Galanga." Voss teaches use of a UV-radiation-absorbing substance selected from a list of UV filters. This list of UV filters is found in lines 57-67 of column 2 and lines 1-22 of column 3 of the Voss patent. The preamble to this list specifies that the Voss composition consist of either "0.1 to 20% of one or more UV filters" or "0.3 to 10% of one or more UV filters".

Applicants' specification and claims disclose and teach the use of the skin-care product, or the components thereof, for protecting against the harmful effects of tyrosinase or chemically induced irritation other than UV radiation, as taught by Applicants' independent claims 11, 21 and 26. Conversely, Voss limits description of its skin-care

product throughout to "a new cosmetic skin-care product against ageing of the skin as an effect of light", as in col. 1, line 1; col. 1, line 55; and col. 2, line 27. By limiting the Voss cosmetic skin-care product to one function, Voss specifically directs away from the function taught by Applicant, which is protection against the harmful effects of tyrosinase or chemically induced irritation other than UV radiation.

Furthermore, the only mention of ethyl p-methoxycinnamate in Voss is in col. 4, line 47. The inclusion of ethyl p-methoxycinnamate, to the extent it is mentioned in this one instance, is as a UV B filter in the amount of 2.0 g in a total emulsion of 100 g. Voss limits inclusion of ethyl p-methoxycinnamate to this one Example 1b, and furthermore, limits the role of ethyl p-methoxycinnamate to the role of a UV B filter at a 2.0% concentration. By such limitation, Voss teaches away from use of ethyl p-methoxycinnamate as anything but a UV B filter in a 2.0% concentration. Applicant's composition's use of ethyl p-methoxycinnamate serves an entirely different function than the Voss composition. Applicant's composition is claimed only in use of ethyl p-methoxycinnamate as protection against the harmful effects of tyrosinase or chemically induced irritation and specifically does not include use of ethyl p-methoxycinnamate for protection against UV radiation.

In order to sustain a rejection under 35 USC 102(b), the cited reference (i.e. Voss) must teach or disclose each and every element of the claimed invention. Because Voss does not teach each and every element of Applicants' amended claims 11, 21 and 26. Applicants' claims 11, 21 and 26 are believed to be allowable over Voss. Applicants' dependent claims 12-15, 19, 20, 22-25 and 28-30 are believed to be allowable over Voss at least because they depend from allowable independent claims 11, 21 and 26.

#### Rejections Under 35 U.S.C. § 103(a)

Claims 13, 23 and 29 stand rejected under 35 USC 102(b) as purportedly being obvious over Voss et al. (U.S. Patent No. 5,972,315; hereinafter "Voss"). Specifically, the Examiner has rejected these claims, "...in view of Example 1b, wherein the concentration of the ethyl p-methoxycinnamate is 2% further in view of the disclosure

which teaches that the percentage range is as low as 0.1%..." Applicants respectfully traverse this rejection for at least the reasons discussed below.

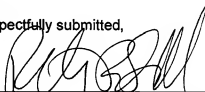
Applicants incorporate their above arguments with regard to Voss, *supra*, and submit that Applicants' amended claims 13, 23 and 26 are believed to be allowable at least, because: i) they contain limitations not taught or suggested by Voss; and ii) they depend from allowable independent claims 11, 21 and 26, respectively.

## CONCLUSION

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Applicants believe no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefore and authorization to charge Deposit Account No. 02-2093 as necessary.

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Respectfully submitted,



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